

REMARKS

The prosecution of this case to date has not been very straightforward. Accordingly, these Remarks attempt to establish the history and status of the case up to and including the current non-final Office Action which was mailed on June 22, 2005, just prior to the expiration of the two month window for filing an Appeal Brief.

No amendment of the claims or specification is being made by this response. Accordingly, after entry of the January 7, 2005 Amendment After Final Rejection, claims 1-14, 29-31, 33-39, and 45-53 are pending. Claims 15-28, 32, and 40-44 have been canceled without prejudice and without disclaimer of the subject matter contained therein. The claim listing beginning on page 2 reflects the latest version of the claims.

As indicated in the latest Action, Applicant has engaged new counsel (a Power of Attorney is being filed concurrently herewith) and the former SPE, Alan Rotman, has retired. As indicated by the Action, there appear to be some unresolved issues. Accordingly, the Examiner has withdrawn the finality of the prior action, and issued this non-final action. Applicants appreciate the Examiner's efforts.

Prior 102 and 103 Rejections

Although the Action indicates "there is no clear record indicating treatment of the 102 and 103 rejections in the record," the rejections were not repeated, and therefore were withdrawn, in light of the amendments and/or arguments made in the responses filed. The 102 rejections were set forth in the March 26, 2002 Office Action rejecting claims 1-44 over Kende et al. and claims 1-52 over Barta et al. Applicants responded, amending the claims and adding new claim 53. The subsequent January 3, 2003 Office Action did not repeat any of the 102 rejections, but cited Barta et al., alone, in a 103 obviousness rejection, relating specifically to

claims 39, 45, 46, and 47. The January 3, 2003 Action also contained a ten-way restriction requirement and a requirement for election of species.

Applicants responded on June 3, 2003, providing amendments and arguments for patentability and electing

with traverse to prosecute the invention of Group I, Claims 1-14, drawn to a method of preparing alpha-sulfonyl derivatives of formula V using a carbonyl intermediate of formula IV. Further, Applicants provisionally elect with traverse the single disclosed compound species from Example 36, (4-[4-(4-chlorophenoxy)-benzenesulfonyl]-1-benzyl-piperidine-4-carboxylic acid hydroxyamide hydrochloride.

The response further argued for joinder of several of the restriction groups.

Another Action issued on September 24, 2003, but never reached Applicants. The same action was remailed, resetting the period for response, on October 25, 2004. The only indication of the restarted period is a handwritten note, found only in the PAIR system and the Office's PALM system--not the mailed copy, signed by B. Gray (Supervisory Docket Clerk). Applicants appreciate the assurances of the Examiner and Ms. Gray that the period was in fact restarted, and agree that the record clearly indicates that the Office has treated it as such, ***nevertheless, Applicants respectfully request a written indication to that effect in the next action, as previously requested.***

Page 2 of the October 25, 2004 Action says "the rejection under 35 U.S.C. 103 has been withdrawn," before setting out a rejection under 35 U.S.C. § 112. Thus, the record is clear that the Office withdrew the obviousness rejections.

Therefore, although we admit this case is not straightforward, we do not agree with the latest Action's comment that the treatment of the 102 and 103 rejections is unclear. It seems quite clear that the rejections were withdrawn in response to Applicants' amendments and/or arguments. Examiner Covington has been with the case since the first action and should be

aware of the history, despite the changes in SPE and Applicants' counsel. These issues need not be addressed again.

Restriction/Election of Species

With respect to the restriction requirement and election of species, the above quoted language clearly demonstrates that Applicants had elected Group I, claims 1-14 and specifically the species of example 36, while arguing against the restriction requirement and requesting rejoinder of specific claims. Confusion about these elections arises from the prior action's indication that the scope of the election would be determined by the Office at a later (and as yet undetermined) time, and Examiner Covington's recollection that undocumented conversation(s) occurred between the former SPE and former counsel.

The confusion in this case is further complicated by inconsistent references as to which claims are pending. For example, the remailed, October 25, 2004, Action Summary indicates that claims 1-53 are pending, claims 1-28 and 48-52 are withdrawn, and that claims 29-47 and 53 are rejected. The text of that action, however, addresses claims 1-14 and 45-47. It should be recalled that Applicants had elected claims 1-14 and argued for rejoinder of several groups. It appears that at least claims 45-47 had been rejoined with claims 1-14, since those claims were examined. Applicants further queried whether claims 28-39 should be rejoined since they depend from elected independent claim 1. The present action appears to partially clarify the situation by including claims 29-31 and 33-39 in Group I along with claims 1-14, yet restricts claims 45-47. The Action also suffers from what appears to be a clerical error, referring to now non-existent groups VII, VIII, IX, and X in a paragraph appearing to be inadvertently copied from a prior action.

Turning now to the merits of the current, June 22, 2005 Office Action, the Office has required restriction among four allegedly patentably distinct inventions below:

- I. Claims 1-14, 29-31, and 33-39, drawn to a method of preparing alpha-sulfonyl derivatives of formula V using a carbonyl intermediate of formula IV;
- II. Claims 45-46 drawn to compounds of the formula IX;
- III. Claims 48-49 drawn to compounds of the formula IX; and
- IV. Claims 50-53 drawn to a method of inhibiting pathological changes mediated by metalloproteinases.

In response to the requirement for restriction, Applicants hereby elect Group I, claims 1-14, 29-31, and 33-39. In doing so, Applicants reserve the right to pursue the subject matter of the non-elected claims in one or more divisional or continuing application(s). Nevertheless, Applicants respectfully traverse the restriction requirement.

As will be appreciated, even if the Office considers the groups of claims to be patentably distinct, §803 of the M.P.E.P. mandates **two** criteria for a proper requirement for restriction: 1)the inventions must be independent or distinct; **and 2)there must be a serious burden on the examiner.** For purposes of initial restriction, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02. Applicants respectfully submit that there is no serious burden on the examiner particularly with regard to Groups I and II, since each of those claims has already been searched and examined.

Summarizing the case description above, original claims 1-52 were subject of an initial search, examination, and action on the merits, resulting in a 102 rejection. The claims were amended to overcome the 102 rejection and a new 103 rejection was issued, along with a *first* requirement for restriction. In response to Applicants' election, claims 1-14 and 45-47 were

again subjected to search, examination, and an action on the merits. The current action sets forth a new restriction requirement, grouping together claims 1-14, 29-31, and 33-39 as group I and claims 45-46 as group II (claim 47 is not grouped anywhere, but we suspect it should be in group II, and Applicants treat it here as if group II includes claim 47). Applicants hereby elect group I, claims 1-14, 29-31, and 33-39 with traverse. At a minimum, Applicants respectfully assert that group II, claims 45-47, should be rejoined with group I, since those claims have previously been searched and examined (twice it would seem). Accordingly, rejoining them here would not unduly burden the examiner. It also appears that claim 53 should be rejoined with the claims of group I, since claim 53 is ultimately dependent from independent claim 1, and is drawn to the methods of group I.

Applicants maintain their election of the species of Example 36, and note that the remaining species are not cancelled, but merely held in abeyance for further treatment upon indication of allowance of the elected species.

For clarity, Applicants elect group I, claims 1-14, 29-31, 33-39, and the species of Example 36, with traverse for the reasons set forth above. Applicants further respectfully request rejoinder of the claims of group II, claims 45-47, with Group I, since they have already been examined. Likewise, Applicants respectfully request that claim 53 be rejoined with the claims of Group I, since it is drawn to the methods of Group I.

Applicants respectfully request reconsideration of the requirement for restriction in light of the above comments.

Accompanying Petition

Applicants have concurrently filed a petition requesting reimbursement of the extension fees as well as the Notice Of Appeal fee previously filed to keep this case pending while awaiting a response from the Office, which ultimately withdrew the finality of the prior action,

thereby obviating the need for the extensions and the Notice Of Appeal. Perhaps more importantly, the petition also requests that the period in question not be calculated as applicant delay in calculating Patent Term Adjustment (PTA). The petition itself discusses the reasons behind this request in greater detail.

Since all pending claims appear to have been searched and subjected to examination at least once previously, Applicants respectfully request that the claims be indicated allowable, and examination of the remaining species be conducted with haste.

Although Applicants do not believe any fee is due, the Commissioner is hereby authorized to debit any fee due or credit any overpayment to deposit account 50-1275.

Early reconsideration and allowance of all pending claims is respectfully requested. The examiner is requested to contact the undersigned attorney if an interview, telephonic or personal, would facilitate allowance of the claims.

Respectfully submitted,

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